

Complete set of claims showing deletions and additions in amended claims.

Deletions are enclosed in brackets with a strikeout line through the respective deletions while insertions are shown underlined, the language remaining from the original specification and/or previous amendments shown in regular type. Claim version identifier markings are enclosed in parentheses.

1. (currently amended) A ~~{paper}~~ decorative wrapping film comprises a planar paper, a first decorative coating and a second decorative coating, said first decorative coating disposed on one surface of said planar paper and said second decorative coating subsequently disposed upon said first decorative coating, said second decorative coating comprising at least one hot transfer inked foil carried on a carrier ~~{having}~~ wherein said at least one said hot transfer inked foil is laminated onto said first decorative coating ~~{a planar wrapping paper}~~ thereby marrying said at least one hot transfer foil to said first decorative coating ~~{planar wrapping paper}~~, said marrying creating said ~~{paper}~~ decorative wrapping film wherein said carrier is removed from said ~~{paper decorative wrapping film}~~ hot transfer foil and said ~~{paper}~~ decorative wrapping film is wound upon a roll for use in wrapping of a substrate.

2. (currently amended) A ~~{paper}~~ decorative wrapping film as in claim 1 wherein said ~~{paper}~~ decorative wrapping film has at least one other hot transfer foil layered onto said ~~{paper}~~ first decorative coating and said second decorative coating of said decorative wrapping film thereby marrying said at least one other hot transfer foil to said first decorative coating and said second decorative coating ~~{planar wrapping paper}~~, said marrying creating said ~~{paper}~~ decorative wrapping film wherein said carrier is removed from said ~~{paper decorative wrapping film}~~ other hot transfer foil and said ~~{paper}~~ decorative wrapping film is wound upon a roll for use in wrapping of a substrate.

~~{3. (canceled) A paper decorative wrapping film as in claim 2 wherein said paper decorative wrapping film has an adhesive applied to a side of said paper decorative wrapping film opposite said one other hot transfer foil, said paper decorative wrapping film wrapped about a substrate to be decorated.}~~

~~{4. (canceled) A paper decorative wrapping film as in claim 1 wherein said paper decorative wrapping film has an adhesive applied to a side of said paper decorative wrapping film opposite said hot transfer foil, said paper decorative wrapping film wrapped~~

~~about a substrate to be decorated.]~~

~~{5. (canceled) A paper decorative wrapping film as in claim 1 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.}~~

~~{6. (canceled) A paper decorative wrapping film as in claim 1 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.}~~

~~{7. (canceled) A paper decorative wrapping film as in claim 2 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.}~~

~~{8. (canceled) A paper decorative wrapping film as in claim 7 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.}~~

~~{9. (canceled) A paper decorative wrapping film as in claim 2 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.}~~

~~{10. (canceled) A paper decorative wrapping film as in claim 9 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.}~~

11. (currently amended) A {paper} decorative wrapping film comprises an embossed paper and a decorative coating, said decorative coating subsequently disposed upon said embossed paper, said decorative coating comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil laminated onto said {an} embossed wrapping paper thereby marrying said at least one hot transfer foil to said embossed wrapping paper, said marrying creating a laminated embossed wrapping paper wherein said carrier is removed from said laminated embossed wrapping paper and said embossed laminated wrapping paper is wound upon a roll for use in wrapping of a substrate.

12. (currently amended) A {paper} decorative film as in claim 11 wherein said embossed laminated wrapping paper has at least one other hot transfer foil layered onto said decorative coating of said embossed layered paper thereby marrying said at least one other hot transfer foil to said {planar} embossed laminated wrapping paper, said marrying creating {a} another laminated embossed wrapping paper wherein said carrier is removed from said another laminated embossed wrapping paper and said another laminated embossed wrapping paper is wound upon a roll for use in wrapping of a substrate.

~~{13. (canceled) A paper decorative film as in claim 12 wherein said laminated embossed wrapping paper has an adhesive applied to a side of said laminated embossed~~

~~wrapping paper opposite said one other hot transfer foil, said laminated embossed wrapping paper wrapped about a substrate to be decorated.]~~

~~{14. (canceled) A paper decorative film as in claim 11 wherein said laminated embossed wrapping paper has an adhesive applied to a side of said laminated wrapping paper opposite said hot transfer foil, said laminated embossed wrapping paper wrapped about a substrate to be decorated.]~~

~~{15. (canceled) A paper decorative film as in claim 11 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.]~~

~~{16. (previously canceled) A decorative molding film as in claim 11 wherein said at least one said hot transfer inked foil is a metallic hot transfer foil.]~~

~~{17. (canceled) A paper decorative film as in claim 11 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.]~~

~~{18. (canceled) A paper decorative film as in claim 12 wherein said at least one said hot transfer inked foil is an opaque colored hot transfer foil.]~~

~~{19. (previously canceled) A decorative molding film as in claim 12 wherein said at least one said other hot transfer inked foil is a metallic hot transfer foil.]~~

20. (currently amended) A {paper} decorative wrapping film comprises a planar paper, a first decorative coating and a second decorative coating, said first decorative coating disposed on one surface of said planar paper and said second decorative coating subsequently disposed upon said first decorative coating, said second decorative coating comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto said first decorative coating [a planar paper wrapping film] thereby creating a laminated {paper} wrapping film having portions of the base color of said {planar paper} wrapping film showing therethrough wherein said carrier is removed from said laminated {paper} wrapping film and said laminated {paper} wrapping film is wound upon a roll for use in wrapping of a substrate.

REMARKS:

This amendment is for the purpose of amending the Specification in the original application by canceling claims 3 - 10, 13 - 15 and 17 - 18 and amending claims 1 - 2, 11 - 12, and 20 to overcome the rejections advanced by the Examiner in the final office action. Applicants believe that these amendments to the specification and claims put the application in condition for allowance and respectfully request reconsideration and allowance of claims 1 - 2, 11 - 12 and 20.

The Official Action rejects claims 1 - 15, 17 - 18 and 20 under 35 U.S.C. 112, second paragraph as being indefinite as it is unclear which is being claimed, a paper or a film. Applicants have canceled claims 3 - 10, 13 - 15 and 17 - 18 and amended claims 1 - 2, 11 - 12, and 20 wherein Applicants have defined the decorative film as the claimed element. Applicants have further amended independent claims 1, 11 and 20 to lay down that layer(s) are added to existing layers to make clear the structure of the novel decorative film. Applicants believe that these amendments to claims have rendered the claims definite and therefore have overcome the rejections thereof based upon 35 U.S.C. 112, second paragraph. Applicants respectfully request reconsideration and allowance of claims 1 - 2, 11 - 12 and 20, however, Applicants also respectfully request the Examiner's assistance in further clarifying the claims in the event that the Examiner still deems the claims to be indefinite.

The Official Action rejects claims 1 - 15, 17 - 18 and 20 under 35 U.S.C. 103(a) as being unpatentable over Kotin, U. S. Patent 5,996,672 in view of Salgado, et al., U. S. patent 6,361,839 B1. Specifically, the Examiner states that Kotin discloses a decorative film having an embossed paper substrate that is easy to print with an adhesive applied to the back of the film. Kotin also discloses a decorative film that is laminated and that a substrate may be wrapped with a printed film where the film is flexible and can be a foil wrap. The Examiner further states that Salgado, et al., teaches a hot stamping foil comprising a carrier where the carrier of the hot stamping foil is removable and/or the hot stamping foil may be applied to wood or paper. Salgado, et al., further teaches that the foil material may be colorless or a variety of colors depending on the temperature and therefore "(I)t would have been obvious to one of ordinary skill in the art to include a colorless (translucent) or colored (opaque) hot stamping foil on the laminated decorative film of Kotin because

Salgado, et al., teaches the conventionality of applying a hot stamping foil to substrates such as wood or paper which Kotin comprises, which improves the transfer of ink images onto a substrate.”

Applicants have canceled claims 3, 4, 13 and 14 wherein the decorative film has an adhesive applied to the side opposite the hot transfer foil for applying the film to a substrate and therefore has overcome the rejection based upon Kotin in view of Salgado, et al., wherein it is no longer a portion of the claimed element to include laminating the film to any substrate as disclosed in Kotin. It is abundantly clear that Kotin merely laminates a commercially available film to a wood slat using a Polyurethane Reactive hot melt adhesive, a process well known in the art and disclosed by Applicants in the prior art statement. The Examiner's attention is drawn to lines 22 - 25 on page 2 of Applicants' Original disclosure filed on 10/23/2000 wherein Applicants admit the practice of applying an adhesive to the reverse side of a commercially available thermoplastic or paper sheet having a thin coat of ink or paint on one side, such structure defining a commercially available decorative wrapping film. In sharp contrast, the gist of Applicants' invention lies in the **decorative wrapping film comprising a planar paper, a first decorative coating and a second decorative coating wherein the first decorative coating has been previously disposed on one surface of the planar paper and wherein the second decorative coating is subsequently disposed upon the first decorative coating, the second decorative coating comprising a hot transfer foil married to the planar wrapping paper thus creating the decorative wrapping film.** (Emphasis added) Kotin merely wraps the fan blade substrate with a single layer of known material and Kotin in view of Salgado, et al., would merely substitute that single layer of known material with a single layer of a temperature dependent thermochromic layer of Salgado, et al. Applicants respectfully draw the attention of the Examiner to page 12 of Amendment A to the Original Specification, Amendment A filed on 07/08/2002, wherein Applicants aver that the claimed element, a “decorative molding wrapping film,” is thus a **previously prepared plain wrapping film (usually already painted, hot ink transferred or otherwise covered with one layer of decoration) having a hot transfer foil laid upon and transferred to the surface of the plain wrapping film,** stripping the carrier from the hot transfer foil and thereafter wrapped

into a roll for later use in wrapping a substrate. (Emphasis added) With regard to claims 11 - 19, Applicants respectfully draw the attention of the Examiner to page 15 of Amendment A to Original Specification, Amendment A filed on 07/08/2002, wherein Applicants declare the use of an embossed decorative film, that is, a wrapping film with actual raised and lowered portions created by an embossing process as the decorative wrapping film, which is then further married to at least one hot transfer foil to decorate the embossed surfaces. Thus, it should be abundantly clear that Applicants have shown that none of the prior art, including the instant references of Kotin and Salgado, et al., alone or Kotin in view of Salgado, et al., or Salgado, et al., in view of Kotin show, describe, suggest or claim a previously prepared wrapping film having at least one hot transfer inked foil laminated thereonto as claimed in Applicants' specification.

In order to fully distinguish Applicants' claims from any combination of references of the prior art, Applicants have amended claims 1, 11 and 20 to set forth that the invention comprises a planar paper, a first decorative coating and a second decorative coating, said first decorative coating previously disposed on one surface of said planar paper and said second decorative coating subsequently disposed upon said first decorative coating, this language appearing verbatim from claim 1. Thereafter, Applicants then set forth that the second decorative coating may comprise multiple coatings and that the second decorative coating is married to the first decorative coating prior to stripping away the carrier and rolling the novel decorative wrapping film upon a roll for subsequent use. In the claims, the recitation of removing the carrier from the hot transfer foil merely completes the process of preparing the newly created novel decorative wrapping film for subsequent use in industrial wrapping processes. If the Examiner persists with rejecting the claims based upon the wrapping of a substrate as merely described by Kotin and the stripping away of the carrier as merely described by Salgado, et al., Applicants respectfully request the Examiner's assistance with making the claims allowable over these references.

In the Final Office Action the Examiner states that Salgado, et al., further teaches that the foil may be colorless or a variety of colors depending upon temperature and that it would have been obvious to include a colorless (translucent) or colored (opaque) hot stamping foil. Accordingly, Applicants have canceled claims 3 - 10, 13 - 15 and 17 - 18 wherein the terms translucent or opaque appear thus rendering the rejection based upon

Straub, Docket 20003

7

14 April 2004

obviousness moot. Applicants respectfully request reconsideration and allowance of the claims remaining in the application, however, Applicants also respectfully request the Examiner's assistance in making the remaining claims allowable if the Examiner persists in advancing the cited references against the remaining claims 1-2, 11-12 and 20. If desired by the Examiner, samples of a commercially available wrapping films of the independent claims with a portion of the existing coating on the commercially available wrapping film overcoated with at least one of the hot stamping foils can be made available in order to assist the Examiner in fully understanding the merits of the novel wrapping film claimed in this application.

Applicants believe that by canceling claims 3 - 10, 13 - 15 and 17 - 18 and amending claims 1 - 2, 11 - 12, and 20 to specifically recite that the decorative wrapping film is the claimed element and that the added printing foils are married to a previously decorated wrapping film have overcome the rejection of these claims based upon under 35 U.S.C. 112, second paragraph and 35 U.S.C. 103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 2, 11 - 12 and 20 remain in this application and Applicants respectfully request reconsideration and allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

Respectfully submitted,

Herbert M. Straub, Martin D. Straub
and Timothy D. Ryan

Joint Inventors

By


Richard L. Marsh, Agent

Registration No. 31,637

4116 E. Latoka

Springfield, Missouri 65809

Date: 14 April 2004

Phone: (417) 887-8441
(417) 887-3731 (home)

Fax: (417) 887-8441

Straub, Docket 20003

8

14 April 2004